

REMARKS

The Applicant has considered the Office Action dated July 7, 2005, and acknowledges the Examiner's comments therein with appreciation. The Applicant's counsel also wishes to acknowledge Examiner Solola's courtesy and helpfulness during the earlier telephone discussions relating to the restriction requirements.

Presented herein to replace claims 1-9 are new claims 35-40. It is noted that new claims 35-40 are presented for clarity (rather than as potentially confusing amendments to claims 1-3), and that no new matter is added by these claims. Claim 35 presents a generic formula for the Schiff base-containing compound (first structure) and the salen-ligand containing compound (second structure) of the present invention. Claim 36 presents a narrower generic formula for the salen-ligand containing compound of the invention. Claims 37-40 properly depend from claim 36. Support for these amendments is found in the Specification at page 4, lines 2-5 ("In another aspect, L may be a Schiff base-containing ligand.") and lines 5-8 ("In one embodiment, L may be a salen ligand which is bidentate, quadridentate, or greater."). See also Figures 1, 2, and 5 of the Specification as filed, which alone provide full support for the formulae presented in claims 35 and 36. Still further, original claims 1-3 (now canceled in favor of new claims 35-36) clearly state that L is a chelating ligand (claim 1) which may be a Schiff base-containing ligand (claim 2) or a salen ligand (claim 3). Minor revisions to the Specification are also provided to more fully present these generic formulas therein.

The Applicant also would draw the Examiner's attention to the fact that it is known in this art field that salen ligands are derivatives of Schiff bases, formed by reducing the Schiff base to change the double bond ($N=C$) into a single bond ($HN-C$). Accordingly, it is believed that the structures of new claims 35-36 are entitled to examination. It is further believed that the amendments address fully the Examiner's rejections under Section 112, 1st and 2d paragraph, and withdrawal of same is respectfully requested.

New claims 41-48 are presented herein also, directed to methods of use of the chemical compounds of claims 35-36. It is noted that these new claims are directed to the subject matter of original claims 10-34, except as noted above relating to the chemical structures presented, and accordingly no new matter is added. Further, Examples 1-6 (pages 8-16) of the Specification as filed provide ample support for process claims 41-48. Because the process claims depend from what are believed to be allowable generic product claims (claims 35 and 36), rejoinder of these method claims is believed to be appropriate,¹ and is respectfully requested.

The Examiner argues that the open-ended term "comprising" in claims 1-2 renders claims 1-9 indefinite. It is believed that new claims 35 and 36 are not indefinite, and withdrawal of the rejection is respectfully requested.

Turning now to page 3 of the Office Action, the Examiner rejects the claims under

¹ Manual of Patent Examining Procedure §821.04(a).

35 U.S.C. §102(a) over the Keizer et al. article in Canadian J. Chem. (2002), Vol. 80, No. 11, pp. 1463-68 (hereinafter the Keizer et al. article). In response, the Applicant respectfully traverses the rejection without amendment, on the grounds that the Keizer et al. article represents the Applicant's own work. In support, the enclosed Affidavit under 37 C.F.R. 1.132 is presented. In accordance with the requirements of *In re Katz*,² the Affidavit establishes that: (1) David A. Atwood, the sole inventor of the subject matter of the present application, is a co-author of the cited Keitzer et al. article and that it describes his own work; and (2) Timothy S. Keizer, Lauren J. De Pue and Sean Parkin, also listed as co-authors on the Keitzer et al. article, are not considered inventors of any of the inventions claimed in the present patent application. Consequently, it is believed that this evidence removes the Keitzer et al. article as a reference under Section 102(a), since it conclusively establishes that the invention presented herein is not "by others" as required by that statute. Withdrawal of the rejection is respectfully requested.

It is believed that the amendments and arguments presented herein place the remaining claims of the present application in condition for allowance. Accordingly, reconsideration of the rejection of the claims, and allowance of all claims of the application is respectfully requested. If any issues remain, however, the Examiner is

² *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

respectfully requested to contact the Applicants' attorney at the telephone number of record in order to expedite the prosecution of this patent application.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450, on Dec 15, 2005

Date 12-1-05 Carolina Perdomo